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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,057	10/22/2003	Kevin J. Zilka	SVIPGP003B	6078
28875	7590	11/18/2005	EXAMINER	
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			VU, THANH T	
			ART UNIT	PAPER NUMBER
			2174	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/691,057	Applicant(s) ZILKA ET AL.	
	Examiner Thanh T. Vu	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is responsive to Amendment, filed 09/22/2005.

Claims 1-41 are pending in this application. In the Amendment, claims 25-41 were added. Claims 1, and 20-24 were amended. This action is made Final.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7-17, and 20-41 provisionally rejected on the ground of nonstatutory double patenting over claims 1-4, 7-17, and 20-41 of copending Application No. 10/691,090. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

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Claims 1-4, 7-17, and 20-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-17 and 20-41 respectively of copending Application No. 10/691,090. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the cited claims of the copending Application No. 10/691,090.

Claims 1-24 provisionally rejected on the ground of nonstatutory double patenting over claims 1-23 of copending Application No. 10/691,061. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Claims 1-21, and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21, and 23 respectively of copending Application No. 10/691,061. Claims 22 and 23 individually are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of copending Application No. 10/691,061. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the cited claims of the copending Application No. 10/691,061.

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Claims 1-20 provisionally rejected on the ground of nonstatutory double patenting over claims 1-20 of copending Application No. 10/695,258. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 respectively of copending Application No. 10/695,258. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the cited claims of the copending Application No. 10/695,258.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the applicant is claiming in claim 19. What is an archival process? What Steps does the process include?

Claims 2, 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "capable of" renders the claim indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-24 are rejected under 35 U.S.C. 102(a) as being anticipated by MS Internet Explorer (IE).

Per claim 1, IE teaches graphical user interface for use in association with a network browser comprising:

a network browser window associated with a network browser for displaying Internet content associated with uniform resource locators (URLs) during network browsing (Fig. 1; elements: 10 and 11);

a plurality of identifiers adjacent to the window in which the content is displayed (Fig. 2; identifiers: 13 and 14);

wherein a user is allowed to pre-select one of the identifiers (Fig. 1; identifier 13 is pre-selected from the history list and content is displayed in area 10);

wherein, after the pre-selection, selected content associated with at least one of the URLs displayed during use of the network browser is correlated with the pre-selected identifier and stored (Figs 2-5; selection of element 20 and 22 of fig. 2, and selection of element of 40 and 41 of Fig. 4 are stored); see list 50 of fig. 5).

wherein the user is allowed to manually enter the pre-selected identifier (fig. 1; a user is allowed to manually enter the identifier in area 11).

Per claim 2, IE teaches a graphical user interface as recited in claim 1, wherein the identifiers are capable of being selected for identifying further information associated there with (Figs. 2-5).

Per claim 3, IE teaches a graphical user interface as recited in claim 1, wherein the URLs are displayed by browsing (Figs. 7-9).

Per claim 4, IE teaches a graphical user interface as recited in claim 1, and further comprising allowing the user to subsequently access the content utilizing the identifier (Fig. 1, user can select identifier 13 and 14).

Per claim 5, IE teaches a graphical user interface as recited in claim 1, wherein the content is correlated upon selection of the content (Figs. 2-5)

Per claim 6, IE teaches a graphical user interface as recited in claim 5, wherein the content is automatically correlated upon selection of the content (Figs. 2-5).

Per claim 7, IE teaches a graphical user interface as recited in claim 1, wherein the identifiers have associated displayed buckets (Figs. 5 and 6; buckets 51; the examiner interprets a bucket to be the folder 51 which contains related history links).

Per claim 8, IE teaches a graphical user interface as recited in claim 7, wherein the identifiers identify the buckets (Fig. 5; identifier 51).

Per claim 9, IE teaches a graphical user interface as recited in claim 8, wherein the identifiers include intellectual property identifiers (Fig. 11, element 10).

Per claim 10, IE teaches a graphical user interface as recited in claim 1, wherein the content includes an entire web page (fig. 1; content 10).

Per claim 11, IE teaches a graphical user interface as recited in claim 1, wherein the content includes documentation in a portable document format (Fig. 10; element 11).

Per claim 12, IE teaches a graphical user interface as recited in claim 1, wherein the date is stored with the content (Fig. 9; date 90).

Per claim 13, IE teaches a graphical user interface as recited in claim 12, wherein the date includes a date at which time the content was discovered (fig. 9; date 90).

Per claim 14, IE teaches a graphical user interface as recited in claim 1, wherein the URL is stored with the content (Fig. 1, URL 11; Figs. 7-9).

Per claim 15, IE teaches a graphical user interface as recited in claim 7, wherein the buckets are accessed via menus (Fig. 6; element 60).

Per claim 16, IE teaches a graphical user interface as recited in claim 15, wherein the buckets are accessed via sub-menus (Fig. 6; element 60).

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Per claim 17, IE teaches a graphical user interface as recited in claim 15, wherein the buckets are selected by being clicked (Fig. 6; double click on 61).

Per claim 18, IE teaches a graphical user interface as recited in claim 1, wherein any content selected during use of the network browser results in automatic correlation with the pre-selected identifier (Figs. 2-5).

Per claim 19, IE teaches an archival process that incorporates the features of claim 1 (Figs. 2-5).

Claim 20 is rejected under the same rationale as claim 1.

Claim 21 is rejected under the same rationale as claim 1.

Claim 22 is rejected under the same rationale as claim 1.

Claim 23 is rejected under the same rationale as claim 1.

Claim 24 is rejected under the same rationale as claims 1 and 13.

Per claim 25, IE teaches a graphical user interface of claim 1, wherein the content involves competing activity (fig. 2; sports link).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over MS Internet Explorer (IE) in view of Rivett et al. ("Rivett", U.S. Pat. No. 2003/0046307).

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IE teaches a graphical user interface as recited in claim 9, wherein a search is capable of being performed (fig. 1; search web icon), but does not teach wherein a search is capable of being performed in association with at least one of a plurality of patents using at least one synonym by: identifying at least one claim associated with one of the patents, extracting a plurality of terms from the claim, identifying at least one synonym associated with at least of the terms, and conducting a search utilizing the terms and at least the at least one synonym. However, Rivett teaches a search is capable of being performed in association with at least one of a plurality of patents using at least one synonym by: identifying at least one claim associated with one of the patents, extracting a plurality of terms from the claim, identifying at least one synonym associated with at least of the terms, and conducting a search utilizing the terms and at least the at least one synonym (figs 22-23B, 148, and 153; [0369], [0395], [0039]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Rivett in the invention of IE in order to have automated tools that automatically process patent-related information and non-patent related information utilizing web client interface (see, Rivett, figs. 148, and 153).

Claims 27-30, Rivett teaches the graphical user interface of claim 26, where in the terms of the claim are retrieved from a database, and are automatically retrieve from a database, noun terms and verb terms of the claim are identified (figs. 22-23B; extracting terms from claims).

Per claim 31, 32 and 35, Rivett teaches the graphical user interface of claim 26, wherein Boolean, AND and OR operators searching are incorporated with the searching based on the terms of claim of the patent (pg. 17; table 2).

Per claim 33 and 34, Rivett teaches the graphical user interface of claim 26, wherein a plurality of the synonyms are identified based on the terms of the claim of the patent utilizing a synonym database ([0395]; thesaurus).

Per claim 36, Rivett teaches the graphical user interface of claim 26, wherein the word "claim" is removed from the terms of the claim of the patent (pgs 17 and 18; tables 2 and 3).

Per claim 37, Rivett teaches the graphical user interface of claim 26, wherein the search is conducted manually upon receiving a user request ([1214]).

Per claim 38, Rivett teaches the graphical user interface of claim 26, wherein the search is conducted automatically at predetermined intervals ([0421, [0422], [0423]).

Claims 39-41, Rivett teaches the graphical user interface of claim 26, wherein the terms are modified based on results of search, user input, and the search automatically ([0394], 0397)).

Response to Arguments

Applicants' arguments in the Amendment have been fully considered but are not persuasive.

Applicant's primary argument is that IE does not teach a user is allowed to pre-select one of the identifier.

The examiner does not agree for the following reasons:

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In this case, IE read on the claim language of a user is allowed to pre-select one of the identifier (see fig. 2 and 3; a user can pre-select identifiers 21 from fig. 2 by clicking on the identifiers, content is display in the browser; in addition a user can also select the identifier by entering input in area 11 and of fig. 1).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Inquiries

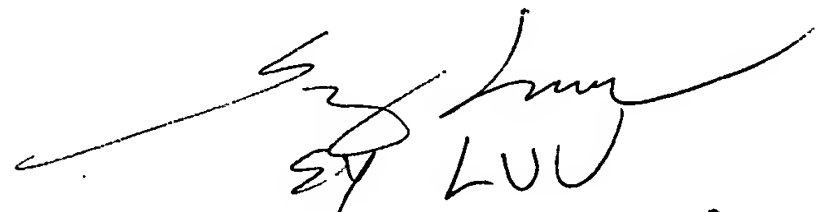
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh T. Vu whose telephone number is (571) 272-4073. The examiner can normally be reached on Mon-Thur and every other Fri 7:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. Vu


T. VU
PRIMARY EXAMINER